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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,751	06/22/2001	Steven S. Kantner	55980USA1B.004	7737

7590 11/20/2001  
Attention: Robert W. Sprague  
Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1619

DATE MAILED: 11/20/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/887,751

Applicant(s)

KANTNER ET AL.

Examiner

Gina C. Yu

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1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

Claims 3 and 12 are objected to because of the following informalities:

Spelling error in the term "methyl methyacrylate" in claim 3, line 5, and the use of the conjunction "and" before the term "antifungal agents" in claim 12, line 6.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 1-9, 11-14 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Mougin (U.S. Pat. No. 6,126,929).

Mougin discloses mascara composition prepared from an aqueous dispersion of film forming copolymer comprising 70 wt % of isobutyl acrylate and 20 wt % of t-butyl acrylate in dodecanethiol, meeting instant claims 1-5, 9, and 14. See Examples 2, 3, and 4. the average particle size of polymer particles is 230 nm, meeting instant claim 8. Claim 12 is met by the disclosure of the buffering active and pigments. Example 8 and 9 also illustrate another formulation comprising 80 wt % of isobutyl acrylate and 20 wt %

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of methyl methacrylate in dodecanethiol, again meeting claims 1-5, 9, and 14. The T<sub>g</sub> of the composition there is -3 °C, meeting instant claim 11. As for instant claims 6 and 7, examiner takes the position that, since Mougin discloses the composition having the same limitation of the claimed invention, the undisclosed measurement of the tack and flexibility test value of the film formed by the composition are inherent.

2. Claims 1-8, and 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolich, Jr. et al. (U.S. Pat. No. 5,662,892).

Bolich discloses hair styling/conditioning compositions containing the copolymers of C1-C18 alkyl esters of acrylic or methacrylic acid in aqueous carrier. See abstract. The monomers of instant claim 1(a)(i) such as n-butyl (meth)acrylate in the amount of 10-95 wt %; and the monomers of instant claim 1(a)(ii) such as dimethyladamentyl (meth)acrylate or isobornyl (meth)acrylate are used in the amount of 10-50 wt %, meeting instant claims . See col. 4, line 47 – col. 5, line 30. The additives of instant claim 12, including thickeners, surfactants and silicone and oil conditioning agents, are disclosed in col. 7, line 55 - col. 21, line 56. Instant claim 11 is met by the disclosure that the linear copolymers form a film having a T<sub>g</sub> of at least about 30 degree Celcius so that the are not unduly stick or tack to the touch. See col. 3, line 64 – col. 4, line 4.

The aqueous carriers of instant claims 14-15, including water, ethanol and propanol are discussed in col. 7, lines 17 – 59. The solvents of instant claim 16, such as C10-C16 hydrocarbon, silicone derivatives, and ethers, isododecane being most preferred. See col. 6, line 28 – col. 7, line 25. As for instant claims 6 –8, examiner takes the position that, since Bolich discloses the composition having the same limitation of the instant

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claims, the undisclosed measurement of the tack or flexibility test value of the film formed by the composition and the average particle size of the copolymer, are inherent.

**Conclusion**


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tongerson et al. (U.S. Pat. No. 5019377, teaching hair styling products comprising low glass transition temperature adhesive copolymers having acrylate esters or methacrylate esters).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
November 14, 2001

  
DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600